

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(Case No. 1551)

In re the Application of:

Joshua R. Zerlan  
Wei Kao

Examiner: not assigned

Group Art Unit:  
not assigned

For: METHOD AND SYSTEM FOR  
AUTOMATIC TESTING OF  
NETWORK ELEMENTS

Commissioner for Patents  
Washington, D.C. 20231

04/30/2001 EFLORES 00000034 09842550

130.00 OP

**PETITION UNDER 37 C.F.R. 1.47(a)  
TO ALLOW SIGNATURE ON BEHALF OF  
INVENTOR WHO CANNOT BE REACHED**

Dear Sir:

Pursuant to 37 C.F.R. § 1.47(a), Applicants respectfully request the Office to allow Joshua R. Zerlan to execute a Declaration for the above-captioned application on behalf of co-inventor Wei Kao, who cannot be reached to sign a Declaration for this application. In support of this Petition, Applicants state as follows:

1. Mr. Zerlan is the only inventor available to sign a declaration for the above-captioned application. As Mr. Kao cannot be reached after diligent effort, Mr. Zerlan has signed a declaration for this application on Mr. Kao's behalf. The signed declaration is attached hereto as exhibit A. Mr. Kao no longer works for Sprint PCS, the intended assignee of the invention.

2. The undersigned hereby declares that a diligent effort was made to reach Mr. Kao and obtain his signed declaration for this invention. The facts proving this effort are as follows:

04/30/2001 EFLORES 00000034 09842550

03 FC:581

40.00 OP

09842550-042504

- a. On February 6, 2001, a review copy of the application, along with a cover letter with instructions and a request for comment, was sent to Mr. Kao at his last known address. A copy of the cover letter is attached hereto as exhibit B.
  - b. Mr. Kao did not return any of several messages left at his last known phone number to solicit comment on the February 6 draft, nor did he provide comments to the draft via mail or e-mail.
  - c. On February 27, 2001, a final copy of the application, a Declaration and Power of Attorney, and an Assignment were sent to Mr. Kao via Federal Express, with a cover letter with instructions and a request to execute and return the documents by March 6, 2001. A copy of the cover letter and the Federal Express Airbill are attached hereto as exhibit C.
  - d. Mr. Kao did not respond to the February 27 communication in any way.
3. Mr. Kao's last known address is 2357 Ridge Court, Apartment 66, Lawrence, Kansas 66046.
  4. Pursuant to 37 C.F.R. §§ 1.47(a) and 1.17(i), Applicants submit herewith a check for the petition fee of \$130.

Respectfully submitted

**McDONNELL BOEHNEN  
HULBERT & BERGHOFF**

Date: 4/25/01

By: Edward K. Runyan  
Edward K. Runyan  
Reg. No. 43,067

## MCDONNELL BOEHNEN HULBERT &amp; BERGHOFF

MBHB

EDWARD RUNYAN  
DIRECT DIAL: (312) 935-2373  
E-MAIL: runyan@mbhb.com

32<sup>ND</sup> FLOOR  
300 SOUTH WACKER DRIVE  
CHICAGO, ILLINOIS 60606  
TELEPHONE: (312) 913-0001  
FACSIMILE: (312) 913-0002

February 6, 2001

Via Federal Express

Mr. Wei Kao  
2357 Ridge Ct., Apt. 66  
Lawrence, KS 66046

CONFIDENTIAL & PRIVILEGED  
ATTORNEY-CLIENT PRIVILEGE

jc997 U.S. PTO  
09/842550  
04/25/01

Re: U.S. Patent Application  
Title: Method and System for Automated Testing of Network Elements  
Inventors: Josh Zerlan, Wei Kao  
Sprint Docket No. 1551  
MBHB Case No. 00-777

Dear Wei:

I am pleased to provide for your review and comment the attached draft patent application directed to the invention of Docket No. 1551. I have also forwarded a copy of the draft application to Josh for his review.

Please carefully review the application to ensure that it accurately describes and claims your invention. In this regard, please recall several important requirements imposed by the U.S. Patent Laws. First, the claims must describe what you believe to be your invention. While we seek to claim the invention as broadly as possible, the claims must not be so broad as to cover what already exists. Second, the description must describe the claimed invention sufficiently to enable one of ordinary skill in the art to carry out the claimed invention without undue experimentation. Third, the description must disclose the best way that you know how to carry out the invention as of the time we file the application. If you have additional information that you believe we should include to satisfy any of these requirements, please let me know.

In addition, please recall that each of the named inventors will become obligated by a "duty of disclosure" under the U.S. Patent Laws, which will require you each to submit to the Patent Office any and all information of which you are aware that a Patent Examiner may consider to be material to patentability, whether alone or in combination with other information. This duty continues to exist for as long as the patent application is pending before the Patent Office, and failure to comply with the duty can render a resulting patent unenforceable in federal court. Therefore, if you have any material information, please provide it to me so that we can submit it to the Patent Office as required.

I look forward to discussing this draft application with you at your earliest convenience.

Very truly yours,

  
Edward Runyan

Enclosures

cc: Steven J. Funk  
Timothy A. Nehls  
Lawrence H. Aaronson